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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,434	03/09/2000	Feng-Nien Ko	11544-003001	3204
26161	7590	04/11/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			COE, SUSAN D	
		ART UNIT		PAPER NUMBER
		1654		

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/522,434	KO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan D. Coe	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 07 February 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3-5,7-9 and 11-37 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) Claim(s) 1,3-5,8,11 and 23 is/are allowed.
- 6) Claim(s) 7 and 9 is/are rejected.
- 7) Claim(s) 24-37 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The amendment filed February 7, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1, 3-5, 7-9, and 11-37 are pending.

***Election/Restrictions***

3. Claims 3-5, 7-9, and 23-37 have previously been withdrawn as being directed to non-elected species. However, claim 1 is now considered allowable; thus, the election of species requirement is withdrawn and these claims are rejoined with claim 1. Claims 12-22 are withdrawn as being directed to non-elected inventions. These claims are drawn to processes and a method of use that will not be rejoined with claim 1 because they are not commensurate in scope with the allowable product in claim 1 (see MPEP 821.04).
4. Claims 1, 3-5, 7-9, 11, and 23-37 are examined on the merits.

***Double Patenting***

5. Claims 24 and 35 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
6. Claims 25, 30, and 36 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4.

7. Claim 31 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 26.
8. Claims 27, 32 and 37 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5.
9. Claim 33 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 28.
10. Claim 34 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 23.

***Claim Objections***

Claims 7 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

11. Claim 7 does not properly depend from claim 1 because claim 7 adds additional compounds outside of the weight limitation of claim 1. Since the American ginseng extract of claim 1 consists essentially of an extract that does not contain compounds of less than 1,000, adding compounds outside this weight limitation improperly broadens the scope and makes it unclear what exactly is allowed to be in the composition.

12. Claim 9 does not further limit claim 1. Claim 1 states that the process of the production of the American ginseng extract consists essentially of extraction with a solvent, centrifugation, and filtration through an ultrafiltration membrane. Claim 9 adds additional method steps to this process. This is improper since the process of claim 1 consists essentially of the steps recited.

13. Claims 26, 28 and 29 are objected to because they depend on claims that are objected to under double patenting; thus, they cannot be considered allowable.

***Claim Rejections - 35 USC § 112***

Claims 7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 7 is indefinite because it claims that the filtrate containing compounds of less than 1,000 is added to the retentate which contains compound greater than 1,000. This is indefinite because claim 1 consists essentially of an American ginseng extract that does not contain compounds of less than 1,000. Adding compounds outside this weight limitation improperly broadens the scope and makes it unclear what exactly is allowed to be in the composition.

15. Claim 9 is indefinite because there is a conflict in scope with claim 1. Claim 1 states that the process of the production of the American ginseng extract consists essentially of extraction with a solvent, centrifugation, and filtration through an ultrafiltration membrane. Claim 9 adds additional method steps to this process. This is improper since the process of claim 1 consists essentially of the steps recited; thus, this conflict in scope is indefinite.

***Conclusion***

16. Claims 1, 3-5, 8, 11 and 23 are allowable. Claims 7 and 9 are rejected. Claims 24-37 are objected to.

17. Please note that MPEP 821.04 states "If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final."

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1654

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

*Susan D. Coe*  
4-7-05

Susan D. Coe  
Primary Examiner  
Art Unit 1654